

REMARKS/ARGUMENTS

1. Introduction

This is a full and timely response to the Office action of January 10, 2008. Claims 1, 10, and 18 have been amended as supported at least by paragraph [0031] and an argument made demonstrating distinction between the claimed invention and known references. No new material has been introduced. Reconsideration of the application is respectfully requested.

2. Background

Claims 1-6 and 8-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically that the run length is “changing” is not supported.

3. Discussion

If understood correctly, the Examiner is suggesting that “the paragraph describing the controller does not disclose how to change the NRZI pattern, only that the pattern has been selected appropriately during the design of the apparatus” and thus the determination that “the subject matter in question was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention” (current Office action, beginning with the last paragraph on page 3).

Also on page 3, second paragraph, of the current Office action, the Examiner states that paragraph [0031] means that the Endec controller generates “*the specific NRZI pattern it was designed to generate. It does not say the controller changes the NRZI pattern.*”

The applicant respectfully traverses the rejection and asserts that a *prima facie*

case with “a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” (MPEP § 2163(III)(A)) has not been presented.

Quoting directly from paragraph [0031], “The Endec controller 105 generates a
5 specific NRZI pattern as required” and “The specific NRZI pattern is designed
according to the relative relationship between the recording speed and the FMD
bandwidth”. However, the applicant is unable to locate teachings that indicate that the
Endec controller cannot or is not capable of generating a different NRZI pattern when
“required” or different NRZI patterns according to “to the relative relationship
10 between the recording speed and the FMD bandwidth”. In fact, paragraph [0031] is
rightfully interpreted as teaching that the Endec controller can and is capable of
generating different NRZI patterns according to “to the relative relationship between
the recording speed and the FMD bandwidth”. The term “selected” in the phrase “a
larger run length can be selected” obviously means there is more than one NRZI
15 pattern to select from (paragraph [0031]). The specific NRZI pattern selected is
designed according to the recording speed, because for all purposes the FMD in any
given recording device is fixed, while as is known, the same given recording device
usually has more than one recording speed. Therefore the specific NRZI pattern
selected also changes with recording speed.

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Watabe in view of Kenjo do not teach generating an NRZI pattern having a run
length designed according to recording speed, but disclose a predefined NRZI pattern
having a fixed run length regardless of recording speed. Watabe, paragraph [0021],
offers 11T as a fixed run length. In that same paragraph, Watabe continues by saying
25 that even at quadruple speed, the required bandwidth of the FDM will not have to be
increased. When the speed is increased (paragraph [0022]), the required bandwidth
“becomes very large”. Thus at best, Watabe may teach increasing bandwidth
according to speed, but the applicant asserts that Watabe in view of Kenjo do not
teach or suggest generating an NRZI pattern having a run length designed for the
30 recording speed. On the other hand, the present claims select an NRZI pattern that was

designed for that particular speed, which when the recording speed is fast enough may require an NRZI pattern with an extended run length (paragraph [0031]) in order to provide adequate APC.

5 **4. Summary**

It is not how to change the NRZI run length that is the focus of the claims and specification. One skilled in the art from the above could easily deduce this. Simply change the values of “d” and/or “k” to change the run length of the NRZI using an appropriate signal or other convention means and the results would be predictable, an
10 indication of possession. **“A patent need not teach, and preferably omits, what is known in the art” (MPEP 2164.01).**

“The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” *Ralston*
15 *Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).” (MPEP 2163.02).

The present application discloses an alternative device and method for accurately maintaining constant laser power levels in high speed recording without requiring
20 special, width extended laser pulses (paragraph [0015]) or a high-cost FMD (paragraph [0006]) by using a low-pass filter (paragraph [0035]) and fixed-duty pulses (paragraph [0034]) having a run length not constrained to the maximum run length in APC mode (paragraph [0031]) generated by an NRZI pattern have a desired run
25 length selected according to the relationship between recording speed and the specific FMD bandwidth (paragraph [0031]). The applicant asserts that the disclosure as described would reasonably convey “to the artisan that the inventor had possession at that time of the later claimed subject matter” as required under the written description requirement.

30 Applicant respectfully requests reconsideration of claims 1-6 and 8-21 and that a

timely Notice of Allowance be issued in this case.

Sincerely yours,

5  Date: 03/28/2008

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